

DOCKET NO.: JJO-0005

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:

Freeman et al.

Serial No.: 08/335,981

Group No.: 3302

Filed: November 8, 1994 Examiner: Michael A. Brown

For: ORTHOPEDIC CASTING BANDAGE

Certificate of Facsimile Transmission

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

On March 20, 1995
Francis A. Paintin
Francis A. Paintin Reg. No. 19,386

Commissioner of Patents & Trademarks
Washington, DC 20231

Sir:

LETTER CONCERNING REEXAMINATION ORDER

The subject application is an application for reissue of Freeman et al., U.S. Patent 5,088,484, granted February 18, 1992. This application was filed on November 8, 1994.

On December 22, 1994, an Order Granting Request For Reexamination was issued in Serial No. 90/003,586 concerning the patent which is the subject of this reissue. The order was signed by Michael A. Brown, Primary Examiner of Group 3300. In an inquiry on March 20, 1995, applicants' attorney was advised that no action had as yet been taken in the subject application for reissue.

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To assist in the advancement of the prosecution of the subject application, applicants suggest that the procedures set forth in MPEP §2285 (copy enclosed) be noted. On page 2200-56, right column, it is stated:

If reexamination is ordered (MPEP §2246), the reexamination file, the reissue application, and the patent file should be delivered to the Office of the Assistant Commissioner for Patents promptly following the mailing of the decision ordering reexamination.

It will be noted on page 2200-57, left column:

The general policy of the Office is to merge the more narrow reexamination proceeding with the broader reissue application reexamination whenever it is desirable to do so in the interests of expediting the conduct of both proceedings.

Applicants suggest that time is of the essence in examination of this application. The MPEP §2285 suggests "promptly" sending the files to the Assistant Commissioner. Moreover, since applicants have copied claims from an issued patent requesting an interference, 37 CFR §1.607 and MPEP §2307 require that examination of this application be conducted with "special dispatch" (see page 10 of applicants Preliminary Amendment filed with this application).

If applicants' undersigned attorney can be of any assistance in further expediting the examination, please call at 215-568-3100.

Date: *March 20, 1995*


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2285

MANUAL OF PATENT EXAMINING PROCEDURE

under 37 CFR 1.530 or subsequent thereto. If a party to the interference, other than the patent owner, is a requester of the reexamination, that party may petition to stay the reexamination proceeding as a part of a reply pursuant to 37 CFR 1.535. If the other party to the interference is not the requester any petition by that party is improper under 37 CFR 1.550(e) and will not be considered. Any such improper petitions will be returned to the party submitting the same. Premature petitions to stay the reexamination proceedings, i.e. those filed prior to the determination (37 CFR 1.515) and order to reexamine (37 CFR 1.525), will be returned by the examining group director as premature. Petitions to stay filed subsequent to the date of the order for reexamination will be referred to the Office of the Assistant Commissioner for Patents for decision. All decisions on the merits of petitions to stay a reexamination proceeding because of an interference will be made in the Office of the Assistant Commissioner for Patents.

ACTION IN INTERFERENCE FOLLOWING
REEXAMINATION

If one or more claims of a patent which is involved in an interference are canceled or amended by the issuance of a reexamination certificate, appropriate action will be taken by the examiner-in-chief under 37 CFR 1.641.

Upon issuance of the reexamination certificate, the patent owner must notify the examiner-in-chief thereof.

2285 Copending Reexamination and Reissue Proceedings [R-4]37 CFR 1.565 Concurrent Office proceedings.

(d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings. Where merger of a reissue application and a reexamination proceeding is ordered, the merged examination will be conducted in accordance with §§ 1.171-1.179 and the patent owner will be required to place and maintain the same claims in the reissue application and the reexamination proceeding during the pendency of the merged proceeding. The examiner's actions and any responses by the patent owner in a merged proceeding will apply to both the reissue application and the reexamination proceeding and be physically entered into both files. Any reexamination proceeding merged with a reissue application shall be terminated by the grant of the reissued patent.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately at the same time as to a particular patent. The reason for this policy is to permit timely resolution of both proceedings to the extent possible and to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Accordingly, if both a reissue application and a reexamination proceeding are pending concurrently on a patent, a decision will nor-

mally be made to merge the two proceedings or to stay one of the two proceedings. The decision as to whether the proceedings are to be merged, or which proceeding, if any, is to be stayed is made in the Office of the Assistant Commissioner for Patents. See *In re Onda*, 229 USPQ 235 (Comr. Pats. 1985).

TIME FOR MAKING DECISION ON MERGING OR
STAYING THE PROCEEDINGS

A decision whether or not to merge the reissue application examination and the reexamination proceeding, or to stay one of the two proceedings, will not be made prior to the mailing of an order to reexamine the patent pursuant to 37 CFR 1.525. Until such time as reexamination is ordered, the examination of the reissue application will proceed. A determination on the request must not be delayed because of the existence of a copending reissue application since 35 U.S.C. 304 and 37 CFR 1.515 require a determination within three months following the filing date of the request. See MPEP § 2241. If the decision on the request denies reexamination (MPEP § 2247), the examination or the reissue applications should be continued. If reexamination is ordered (MPEP § 2246), the reexamination file, the reissue application, and the patent file should be delivered to the Office of the Assistant Commissioner for Patents promptly following the mailing of the decision ordering reexamination. The delivery of the files to the Office of the Assistant Commissioner should not be delayed awaiting the filing of any statement under 37 CFR 1.530 and any reply under 37 CFR 1.535.

If a reissue application is filed during the pendency of a reexamination proceeding, the reexamination file, the reissue application, and the patent file should be delivered to the Office of the Assistant Commissioner for Patents as promptly as possible after the reissue application reaches the examining group.

The decision on whether or not the proceedings are to be merged, or which proceeding, if any, is to be stayed will generally be made as promptly as possible after receipt of all of the files in the Office of the Assistant Commissioner for Patents. However, the decision on merging or staying the proceedings may in certain situations be delayed until any submissions under 37 CFR 1.530 and 37 CFR 1.535 have been filed. Until a decision is mailed merging the proceedings or staying one of the proceedings, the two proceedings will continue and be conducted simultaneously, but separately.

The Office may in certain situations issue a certificate at the termination of a reexamination proceeding, even if a copending reissue application or another reexamination request has already been filed.

CONSIDERATIONS IN DECIDING WHETHER TO
MERGE THE PROCEEDINGS OR WHETHER TO STAY
A PROCEEDING

The decision on whether to merge the proceedings or stay a proceeding will be made on a case-by-case basis based upon the status of the various proceedings with due consideration being given to the finality of the reexamination requested.

CITATION OF PRIOR ART AND REEXAMINATION OF PATENTS

2285

1. Reissue about to issue, reexamination requested.

If the reissue patent will issue before the determination on the reexamination request must be made, the determination on the request should normally be delayed until after the granting of the reissue patent and then be decided on the basis of the claims in the reissue patent. The reexamination, if ordered, would then be on the reissue patent claims rather than the original patent claims. Since the reissue application would no longer be pending, the reexamination would be processed in a normal manner.

Where a reissue patent has been issued, the determination on the request for reexamination should point out to the requester and patent owner that the determination has been made on the claims of the reissue patent and not on the claims of the original patent. If a reissue patent issues on the patent under reexamination after reexamination is ordered the next action from the examiner in the reexamination should point out that further proceedings in the reexamination will be based on the claims of the reissue patent and not on the patent surrendered.

Wording similar to the following may be used in the examiner's Office action.

"In view of the surrender of original patent ____ and the granting of reissue patent number ____ which has been issued on ____, 19__, all subsequent proceedings in this reexamination will be based on the reissue patent claims."

Where the reissue patent has issued prior to the filing of a request for reexamination of the parent patent, see MPEP § 2258.

2. Reissue pending, reexamination request filed.

Where a reissue patent will not be granted prior to the expiration of the three month period for making the determination, a decision will be made as to whether the proceedings are to be merged or which proceeding, if any, is to be stayed after an order to reexamine has been issued. The general policy of the Office is to merge the more narrow reexamination proceeding with the broader reissue application examination whenever it is desirable to do so in the interests of expediting the conduct of both proceedings. In making a decision on whether or not to merge the two proceedings consideration will be given to the status of the reissue application examination at the time the order to reexamination the patent pursuant to 37 CFR 1.525 is mailed. For example, if examination of the reissue application has not begun, or if a rejection of the primary examiner has not been appealed to the Board of Patent Appeals and Interferences pursuant to 37 CFR 1.191, it is likely that a merger of the reissue application examination and the reexamination proceeding will be ordered by the Office of the Assistant Commissioner for Patents. If, however, the reissue application is on appeal to the Board of Patent Appeals and Interferences or the courts that fact would be considered in making a decision whether to merge the proceedings or stay one of the proceedings. See *In re Stoddard*, 213 USPQ 386 (Comr. Pats. 1982); and *In re Scragg*, 215 USPQ 715 (Comr. Pats. 1982).

If such a merger of the proceedings is ordered, the order merging the proceedings will also require that the patent owner place the same claims in the reissue application and in the reexamination proceeding for purposes of the merged proceedings. An amendment may be required to be filed to do this within a specified time set in the order merging the proceedings.

If the reissue application examination has progressed to a point where a merger of the two proceedings is not desirable at that time, then the reexamination proceeding will generally be stayed until the reissue application examination is complete on the issues then pending. After completion of the examination on the issues then pending in the reissue application examination, the stay of the reexamination proceeding will be removed and the proceedings either merged or the reexamination proceeding will be conducted separately if the reissue application has become abandoned. The reissue application examination will be reopened, if necessary, for merger of the reexamination proceeding therewith.

If a stay of a reexamination proceeding has been removed following a reissue application examination, the first Office action will be given a shortened statutory period for response of one month unless a longer period for response clearly warranted by the nature of the examiner's action. The second Office action will normally be final and also have a one month period for response. These shortened periods are considered necessary to prevent undue delay in terminating the proceedings and also to proceed with "special dispatch" in view of the earlier stay.

If the reissue application examination and the reexamination proceeding are merged, the issuance of the reissue patent will also serve as the certificate under 37 CFR 1.570 and the reissue patent will so indicate.

3. Reexamination proceedings underway, reissue application filed.

When a reissue application is filed after a reexamination proceeding has begun following an order therefor, the reexamination, patent, and the reissue files should be forwarded to the Office of the Assistant Commissioner for Patents for consideration as to whether or not to merge the proceedings or stay one proceeding.

Where reexamination has already been ordered prior to the filing of a reissue application, the following factors may be considered in deciding whether to merge the proceedings or stay one proceeding:

a. The status of the reexamination proceeding: For example, has a statement and reply been received, a first Office action been mailed, a final rejection been given, or printing of certificate begun?

b. The nature and scope of the reissue application: For example, are the issues presented in the proceeding the same, overlapping, or completely separate; and are the reissue claims broadening or related to issues other than rejections based on patents or printed publications?

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SENDER'S NAME: Francis A. Paintin

PAGES TO FOLLOW: 5

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PLEASE HAVE THIS PAPER DELIVERED TO MICHAEL A. BROWN, PRIMARY EXAMINER, AS SOON AS POSSIBLE.

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